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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,527	06/23/2003	Yasuhito Watanabe	D-1504	7555

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ALEXANDRIA, VA 22314-2848

EXAMINER
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MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/600,527	WATANABE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas A. Morrison	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/21/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04/21/2005</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections – 35 USC§112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-11 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In particular, claim 1 and its dependent claims 2-11 require regulating means for forming a space with a predetermined distance to the platen roller in a direction away from the platen roller. Also, claim 14 and its dependent claim 15 require regulating means for forming a space having a predetermined distance outside the guide means at a side opposite to the backup guide means. It is unclear where the space is located. Specifically, it is unclear what two elements the space is located between in independent claims 1 and 14.

Also, independent claim 14 recites the limitation "the side opposite to the guide means" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 4, this claim appears to have limitations that are contradictory. In particular, it is unclear how the platen roller is disposed at an **upstream side** relative to the reading position in a **direction** that the **platen roller transports the original...** It

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appears from the figures of the instant application that a platen roller (27) is located upstream of a reading position. If this is true, one possible way to amend claim 4 would be to change this claim to recite wherein said platen roller is disposed upstream relative to the reading position.

Regarding claims 5 and 6, claim 5 appears to have limitations that are contradictory. It is unclear how the first transport means is disposed at the **upstream side** relative to the platen roller **in the direction** that the **platen roller transports the original...** It appears from the figures of the instant application that a first transport means (28) is located upstream of the platen roller (27). If this is true, one possible way to amend claim 5 would be to change this claim to recite first transport means disposed upstream relative to the platen roller for transferring the original to the reading position, said platen roller being disposed between the first transport means and the reading position.

Regarding claim 13, this claim appears to have limitations that are contradictory. It is unclear how the platen roller is disposed at an **upstream side** relative to the reading position **in a predetermined direction** that the **platen roller transports the original...** It appears from the figures of the instant application that a platen roller (27) is located upstream of a reading position. If this is true, one possible way to amend claim 13 would be to change this claim to recite wherein said platen roller is disposed upstream relative to the reading position.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,887,866 (Yamauchi et al.) or U.S. Patent No. 5,816,569 (Hoshi et al.). In particular, both Yamauchi et al. and Hoshi et al. disclose all of the limitations set forth in claims 1, 3-7, 11 and 14.

Regarding claim 1, Figs. 38-39 of Yamauchi et al. and Hoshi et al. show an automatic document feeder (near 6) for feeding an original, including a reading portion (circled portion) having a reading position (near 28) for reading the original;

a platen roller (23) for transporting the original at the reading portion (near 28);  
guide means (28) arranged relative to the platen roller (23) to form a curved original path together with the platen roller (23);

regulating means for forming a space with a predetermined distance to the platen roller (23) in a direction away from the platen roller (the document feeder is configured such that there is a space between the platen roller 23 and a platen 40. In other words, document feeder includes structure that forms a space with a predetermined distance to the platen roller 23 in a direction away from the platen roller 23, which can be considered to be regulating means); and

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pressing means (40) for pressing the guide means (28) to the platen roller (23) so that the original moves the guide means (28) toward a side opposite to the platen roller (23) when the original enters between the platen roller (23) and the guide means (28).

Regarding claim 3, as best understood from the drawings of the instant application, Yamauchi et al. and Hoshi et al. also disclose that the platen roller (23) is disposed at a position away from the reading position (near 28) in the original reading path.

Regarding claim 4, as best understood from the drawings of the instant application, Yamauchi et al. and Hoshi et al. also disclose that the platen roller (23) is disposed at an upstream side relative to the reading position (near 28) in a direction that the platen roller (23) transports the original.

Regarding claim 5, as best understood from the drawings of the instant application, Yamauchi et al. and Hoshi et al. also disclose first transport means (22) disposed at the upstream side relative to the platen roller (23) in the direction that the platen roller (23) transports the original for transferring the original to the reading position (near 28), and the platen roller (23) is disposed between the first transport means (22) and the reading position (near 28).

Regarding claim 6, Fig. 39 of Yamauchi et al. and Hoshi et al. show second transport means (to the right of 12) for transferring the original transported by the platen roller (23) from the reading position (near 28).

Regarding claim 7, Figs. 38-39 of Yamauchi et al. and Hoshi et al. show that the guide means (28) is formed in a flexible transparent film member.

Regarding claim 11, Figs. 38-39 of Yamauchi et al. and Hoshi et al. show that the platen roller (23) is supported at a predetermined position above the platen (40).

Regarding claim 14, Figs. 38-39 of Yamauchi et al. and Hoshi et al. show an automatic document feeder (near 6) for feeding an original, including

a reading portion (circled portion) having a reading position (near 28) for reading the original;

transport means (22) for transferring the original to the reading position (near 28) of the reading portion (circled portion);

backup guide means (38, 117 and 118) arranged along a direction that the transport means (22) transports the original;

guide means (28) situated adjacent to the backup guide means (38, 117 and 118) to form an original reading path together with the backup guide means (38, 117 and 118);

regulating means for forming a space having a predetermined distance outside the guide means at a side opposite to the backup guide means (38, 117 and 118) (i.e., the document feeder is configured such that there is a space between the guide means (28) and a platen 40. In other words, the document feeder includes structure that forms a space with a predetermined distance outside the guide means at a side opposite to the backup guide means (38, 117 and 118), which can be considered to be regulating means); and

pressing means (40) for pressing the guide means (28) against the backup guide means (38, 117 and 118) so that the original moves the guide means (28) toward the side opposite the guide means when the original enters between the backup guide means (38, 117 and 118) and the guide means (28). No function is recited for the backup guide means. As such, the guide means (38, 117 and 118) in Fig. 38 of Yamauchi et al. and Fig. 38 of Hoshi et al. is considered to be a backup guide means as claimed.

3. Claims 1-3, 7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 2000-327168 (included with previous non-final Office Action of 11/26/2004). In particular, Japanese Publication No. 2000-327168 discloses all of the limitations set forth in claims 1-3, 7 and 9-12.

Regarding claim 1, Figs. 1-2 show an automatic document feeder (1) for feeding an original, including a reading portion (circled portion) having a reading position for reading the original;

a platen roller (24) for transporting the original at the reading portion (circled portion);

guide means (21) arranged relative to the platen roller (24) to form a curved original path together with the platen roller (24);

regulating means for forming a space with a predetermined distance to the platen roller (24) in a direction away from the platen roller (the document feeder is configured such that there is a space between the platen roller 24 and a platen 17. In other words, document feeder includes structure that forms a space with a predetermined distance to

the platen roller 24 in a direction away from the platen roller 24, which can be considered to be regulating means); and

pressing means (cantilever portions supporting 21 on both ends in Fig. 1) for pressing the guide means (21) to the platen roller (24) so that the original moves the guide means (21) toward a side opposite to the platen roller (24) when the original enters between the platen roller (24) and the guide means (21).

Regarding claim 2, Fig. 1 shows a platen (17) at which the reading portion is disposed, the guide means (21) being located between the platen (17) and the platen roller (24), and the regulating means forming a space between the platen roller (24) and the platen (17).

Regarding claim 3, Fig. 1 shows that the platen roller (24) is disposed at a position away from (i.e., above) the reading position in the original reading path.

Regarding claim 7, Figs. 1-2 show that the guide means (21) is formed in a flexible transparent film member.

Regarding claim 9, the pressing means (cantilever portions supporting 21 on both ends in Fig. 1) inherently includes fastening means for fastening one end of the transparent film member (21) to one of the cantilever portions that supports 21 in Fig. 1. Also, the other one of the cantilever portions that supports 21 in Fig. 1 can be considered to be supporting means for bending and supporting the transparent film member (21) so that the transparent film member is elastically pressed against the platen roller (24). See Fig. 1.

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Regarding claim 10, the pressing means (cantilever portions supporting 21 on both ends in Fig. 1) inherently has a fastening member for fastening one end of the transparent film member (21) to one of the cantilever portions that supports 21 in Fig. 1. The other one of the cantilever portions that supports 21 in Fig. 1 can be considered to be tension application means for applying tension to the transparent film member (21) to press against the platen roller (24).

Regarding claim 11, Figs. 1-2 show that the platen roller (24) is supported at a predetermined position above the platen (17).

Regarding claim 12, Figs. 1 and 2 show an automatic document feeder (1) for feeding an original, including

a reading portion (circled portion) having a reading position for reading the original;

a platen roller (24) disposed at a position away from the reading position in a predetermined direction (i.e., above the reading position) and transporting the original at the reading position in the predetermined direction;

transparent flexible guide means (21) arranged relative to the platen roller (24) to form a curved original reading path together with the platen roller (24); and

pressing means for pressing the transparent flexible guide means (21) against the platen roller (24).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. or Hoshi et al. as applied to claim 1 above, and further in view of Lin. In particular, Yamauchi et al. and Hoshi et al. both disclose all of the elements, except for the guide member movable freely for pressing the original against the guide means at the reading position.

Lin discloses that it is well known to use a guide member (50, 502) movable freely for pressing an original against a guide means (144) at a reading position, so that wrinkles are removed from the original via the guide member to improve image reproduction. It would have been obvious to one of ordinary skill in the art at the time of the invention, to provide the document feeder of Yamauchi et al. or Hoshi et al. with a guide member that presses the original against the guide means, to remove wrinkles and improve image reproduction, as taught by Lin.

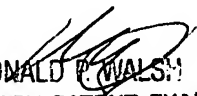
### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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